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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/711,111

08/24/2004

Vivienne M. Heitlauf

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09/26/2006

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EXAMINER

CHOI, JACOB Y

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,111

Applicant(s)

HEITLAUF, VIVIENNE M.

Examiner

Jacob Y. Choi

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Oct. 12 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. Claim 1 is objected to because of the following informalities: the term "*captively*" in line 4 is not a word. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

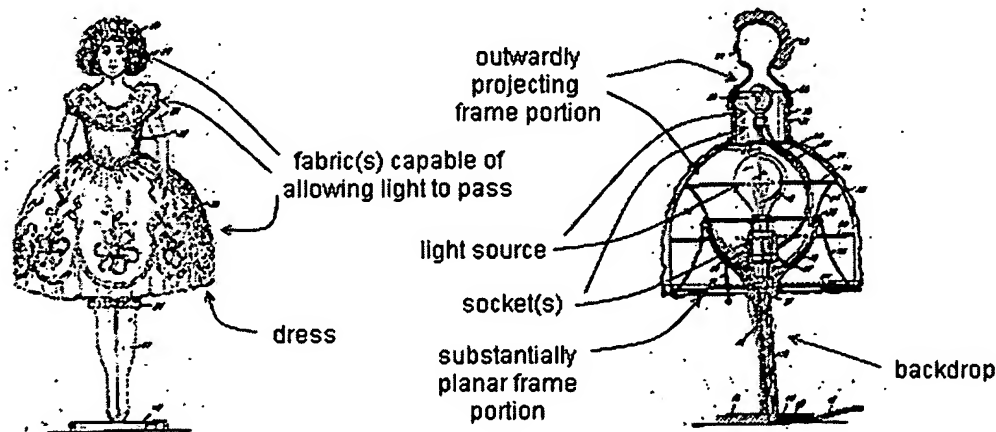
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over D. R. Sparks (USPN 1,385,641) in view of Westfall (USPN 6,663,259).

Regarding claim 1, D. R. Sparks discloses a frame (e.g., 22-24) having a *substantially* planar portion (e.g., 24) and an outwardly projecting portion (e.g., 23), the frame being adapted to receive the decorative figurine (e.g., 29, 27, 31, 32, 21), and the outwardly projecting portion (e.g., 23) having a plurality of curved members (e.g., Figure

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2) configured to form a dress-shaped lampshade structure (e.g., Figure 1), a stand (e.g., 10, 12) coupled to the frame for suspending the frame from a separate structure, a light socket (e.g., 17) positioned between the outwardly projecting portion of the frame (e.g., 23) and the planar portion (e.g., 24) of the frame, configured to operatively receive a light source (e.g., 18, 34) and having means for selectively turning the light source on and off (e.g., 19; paragraph 2, lines 60-80; "... A flexible pull chain 19 extends from the socket through a hole 20 in the bowl and depends therefrom ... etc."), and fabric (e.g., 29, 27, 31, 32, 21) positioned over at least the outwardly projecting portion of the frame, and wherein at least a portion of the fabric is capable of allowing light from the light source to pass through the fabric (e.g., paragraphs 2-3, lines 100-30; ... *while the skirt 32, which is of some sheer translucent material, as silk, extends from the lower edge of the waist ... under portion of the dress in cooperation with the bowl 16 effectually conceals the light bulb and gives a very pleasing external appearance to the lamp ... the head and penetrate the material of which it is composed in a diffused glow ... The lower light is further diffused through the dress, and a soft light is shed downwardly through the under portion 33 ... etc.*").



D. R. Sparks fails to disclose a hook coupled to the frame for suspending the frame from a separate structure (e.g., as a supporting structure).

Westfall similarly teaches a decorative lighting frame with a rigid support (e.g., 10) in combination with a variety of different decorative elements including decorative fabric (e.g., Figures 2 and 5-11), where a hook (e.g., 22) coupled to the frame for suspending the frame from a separate structure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify decorative lamp frame structure of D. R. Sparks with a hook of Westfall to provide an alternative mounting structure (e.g., other than floor standing) to place and/or hang the lamp frame to other structure (e.g., wall). In other words, the modification would have provided an additional benefit of supporting the frame to other separate structure.

Note: Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification. *In re Mraz*, 173 USPQ 25 (CCPA 1972).

It has been held that the recitation that an element is "*adapted to*" & "*capable of*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 2, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses the *substantially* planar portion (e.g., 24) of the frame is configured to be positionable contiguous to an adjacent structure (e.g., Figure 2).

Regarding claim 3, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses a backdrop member (e.g., 12) coupled to the frame, the backdrop member having a back surface and the back surface being positionable against a flat surface (e.g., 10) to help stabilize the frame when the frame is suspended by the floor.

Regarding claim 4, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses a material positioned across a bottom portion of the apparatus to soften any glare (e.g., paragraphs 2-3, lines 100-30) emitted from the light source (e.g., 18, 34).

Regarding claim 5, D. R. Sparks in view of Westfall discloses the claimed invention, explained above.

Westfall teaches the frame being made of a rigid material such as metal or plastic ... etc. (e.g., column 4, lines 60-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize other rigid material such as plastic instead of wires, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design variation. *In re Leshin*, 125 USPQ 416.

Regarding claim 6, D. R. Sparks in view of Westfall discloses the claimed invention, explained above. In addition, D. R. Sparks discloses the frame is made from wire (e.g., column 2, lines 80-90; "... *curved wires 23 ... circumferential wires 24 ... etc.*").

Regarding claim 7, means for preparing the surface of the frame, whereby the fabric adheres more easily to the frame (e.g., columns 2-3, lines 80-40; "... *it is secured in a suitable manner. This under portion of the dress is cooperation with the bowl 16 effectually conceals the light bulb ... The shade is preferably proportioned to show approximately the amount of figure as represented at 11, as very much more or less of a figure would detract from the general shape ... etc.*").

Regarding claims 8-14, D. R. Sparks in view of Westfall discloses the structural limitations of claimed invention, except for specific method of a use of the particular structure.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to specify detailed method of use of the particular structure of D. R. Sparks in view of Westfall.

Note: The method of forming the device is not germane to the issue of patentability of the device itself. Therefore, limitation(s) has not been given patentable weight.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

C. Fischer (USPN 1,639,493) – boudoir lamp

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jacob Y Choi
Examiner
Art Unit 2875



JC